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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,502	08/31/2009	7,139,371	007458.00001	7633

7590 02/11/2015
NIRO, SCAVONE, HALLER & NIRO
181 W. MADISON
SUITE 4600
CHICAGO, IL 60602

EXAMINER

CRAVER, CHARLES R

ART UNIT	PAPER NUMBER
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3992

MAIL DATE	DELIVERY MODE
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02/11/2015

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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95/001,164	04/01/2009	7139371	29776.128	5198

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EXAMINER

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

CISCO SYSTEMS, INC., SKYPE TECHNOLOGIES SA
and RTX TELECOM A/S
Requesters Respondents and Cross-Appellants

v.

RIPARIUS VENTURES, LLC
Patent Owner Appellant and Cross-Respondent

Appeal 2013-006854
Reexamination Control 95/000,502 and 95/001,164 (merged)
Patent 7,139,371 B2
Technology Center 3900

Before JOHN A. JEFFERY, KEVIN F. TURNER, and
STANLEY M. WEINBERG, *Administrative Patent Judges*.

WEINBERG, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Patent Owner Riparius Ventures, LLC (“Riparius”) requests rehearing (Req. Reh’g) under 37 C.F.R. § 41.79 in the above-entitled *inter partes* reexamination of US 7,139,371 B2 (“the ‘371 Patent) with respect to the conclusion of the Patent Trial and Appeal Board (“Board”) that the Examiner did not err in rejecting claims 1-22. Decision on Appeal mailed on March 3, 2014. (“Dec.”). Requester Cisco

Systems, Inc. (“Cisco”) opposes the Request for Rehearing in Comments filed on May 2, 2014 (“Cisco Comments”). Requesters Skype Technologies SA and RTX Telecom A/S (“Skype”) also oppose the Request for Rehearing in Comments filed on May 5, 2014 (“Skype Comments”).

37 C.F.R. § 41.79(b) states in part that “[t]he request for rehearing must state with particularity the points believed to have been misapprehended or overlooked in rendering the Board’s opinion reflecting the decision. Arguments not raised in the briefs before the Board and evidence not previously relied upon in the briefs are not permitted in the request for rehearing” with certain exceptions not applicable here.

We deny rehearing.

CLAIMS 7 AND 21

Riparius contends that our Decision overlooked and failed to address dependent claims 7 and 21. Req. Reh’g 1-2, 5-6.

Claim 7

Claim 7 recites: “A device as in claim 1 wherein said remote cordless base unit comprises circuits separated into isolated millivolt level audio transmit and receive.”

Riparius’s contention that its Specification disavows a standard telephone

Our Decision recognized Riparius’s contention, relying upon *In re Abbott Diabetes Care Inc.*, 696 F.3d 1142 (Fed. Cir. 2012) (“*Abbott Diabetes*”), that the ‘371 Patent’s creation of a unique device constitutes a disavowal of the use of a standard telephone. Dec. 24-25. We concluded, nevertheless, that “the ‘371 Patent’s Specification does not disavow a standard telephone and the claim [claim

1] does not preclude a standard cordless telephone.” Dec. 25. We based our conclusion in part upon the following statements in the ‘371 Patent: “In one embodiment the Base 105 and Handset 107 communicate using *standard* 900 mhz radios.” Col. 3, ll. 4-9 (emphasis added). “In other embodiments of the invention. . . a *standard* Cordless Telephone Circuit 720 was modified only to the extent of adding a balanced Hybrid Circuit 710 to separate transmit and receive audio from the POTS Tip and Ring 715.” Col. 6, ll. 20-25 (emphasis added). At the Oral Hearing, Riparius acknowledged that the discussion beginning at column 6, line 20 described an embodiment of the invention: “Would I go back and maybe ask the patent prosecutor why he put in other embodiments of the invention at column 6 beginning at line 20? Sure, I would say that shouldn’t be in there and that’s a good point that the requesters made.” Oral Hearing Transcript (“Tr.”) 49:8-11. Riparius now asks us to reconsider our conclusion that the ‘371 Patent does not disavow a standard telephone: “Respectfully, the specification does disavow a standard telephone. The specification could not be more clearer that standard telephones, and standard telephone adapters, are verboten.” Req. Reh’g 5.

Riparius bases its rehearing request on parts of its Specification that refer to a specialized device, a unique device, circuitry that differs significantly from a standard telephone, and how its device overcomes prior art deficiencies. Req. Reh’g 2-4. More specifically, Riparius refers to statements in columns 1, 2, 6, and 7 of the Specification. Even more specifically, Riparius’s citation to column 6 refers to lines 53-61. Riparius does not refer to the column 6 citation we identified in the Decision and does not explain why our reliance upon that column 6 citation was erroneous. Riparius also does not contend that our interpretation of *Abbott*

Diabetes was incorrect or that our application of *Abbott Diabetes* to the facts of this case was incorrect.

Accordingly, Riparius has not persuaded us that we misapprehended or overlooked parts of its Specification in our discussion of whether its Specification disavows a standard telephone.

Riparius's contention that claim 7 identifies a unique device

As Riparius notes, our Decision “conclude[d] that Riparius has not identified elements that are recited in the claim [claim 1] to make it unique and which cannot be imported into the claim from the Specification.” *See* Req. Reh’g 5; Dec. 26.

Riparius contends that

the Decision fails to address claim 7 , [which] expressly provides isolated circuits. . . . Claim 7 adds precisely what the specification describes at column 6, lines 53-61, that is, isolated transmit and receive circuits that make the invention different from a standard telephone. . . . Erikson and Prentice concededly use standard telephones (Decision 25).

Req. Reh’g 5-6.

Our Decision concluded that Riparius had not argued claim 7 “separately with particularity as obvious over Erikson in view of Prentice.” Dec. 29. A summary of pertinent parts of the reexamination and the briefs presented to us shows the reasons for our conclusion.

The Examiner adopted Cisco’s proposed rejection of claim 7 for the reasons set forth on Cisco’s Request pages 140-141 and page 19 of Cisco’s Exhibit U attached to its Request. *See* RAN 23. Applying the Erikson reference to claim 7, Cisco’s Request page 140, in turn, stated “Erikson teaches that the audio transmit and receive should be isolated from each other: ‘Thus, the podule 300 supplies

signal isolation, provides power, and completes a two wire to four wire conversion.”” Neither Riparius’s Appeal Brief nor its Rebuttal Brief discusses with particularity the Examiner’s adopted rejection of claim 7. Riparius’s Rehearing Request does not point us to anything in its Appeal Brief or in its Rebuttal Brief showing that it did, in fact, contend with particularity that the rejection of claim 7 over Erikson in view of Prentice as adopted and applied by the Examiner was erroneous.

Riparius’s Appeal Brief acknowledged that “Erikson and Prentice are the only references in rejections 4 and 18.”¹ App. Br. 24. The Appeal Brief provided “a summary just for claims 1 and 7” on pages 27 and 28 of its Appeal Brief. The summary consisted of a column listing rejection numbers, a column identifying the references relied upon for each rejection number, and a column captioned “use of standard phones.” For the rejection of claim 7 in rejection 4, the summary identified the Erikson and Prentice references and, in the “use of standard phones” column stated “Both use a standard phone.” App. Br. 28.

Riparius’s Appeal Brief provided another summary table with respect to the “emulation” limitation in claim 1 stating: “Here is the summary table above, but now including the omission of software as well as the comments in the first table, again just for claims 1 and 7.” App. Br. 34. For this latter summary table, the last column was captioned “use of standard phones and absence of emulation.” App. Br. 34-35. For the rejection of claim 7 in rejection 4, the last column stated, “Both use a standard phone. Neither emulates.” App. Br. 35.

¹ These numbers refer to Riparius’s identification of the rejections in its Appeal Brief. *See* App. Br. 8-11. The Examiner used a different numbering system. *See* RAN 23-24, 27-31.

Neither the first summary table, nor the few sentences following the first summary table, specifically addressed the limitations of claim 7 or the Examiner's adoption of Cisco's application of Erikson to claim 7. *See* App. Br. 28-29.

Following the second summary table, the Appeal Brief stated, in part: “(And, even if claim 1 did not require the use of a non-standard phone, claim 7 certainly does because it explicitly requires that a standard, unisolated two-wire configuration cannot be used. *See* claim 21, too).” App. Br. 36. This statement, however, asserts language that is not recited in claim 7. *Compare* claim 7's recitation of “circuits separated into isolated millivolt level audio transmit and receive” *with* the Appeal Brief's statement “a standard, unisolated two-wire configuration cannot be used.” The statement accordingly did not specifically address the limitations of claim 7 or the Examiner's adoption of Cisco's application of Erikson to claim 7.

Although Riparius's Rebuttal Brief did not refer expressly to claim 7, it did provide the following argument that could be construed as referring to claim 7:

Cisco says at page 12 that Erikson uses a standard telephone. Cisco says that a two to four wire conversion is provided through Erikson's podule, but the '371 says such interfacing does not work. ('371 patent, Exhibit A, col. 1, lines 36-38). A unique device is created, rather than adapting a two wire (standard) telephone ('371 patent, Exhibit A, col. 6, lines 57-63).

Reb. Br. 7.

Riparius's argument, however, was a truncated summary of Cisco's argument. In part, Cisco stated:

Erikson also teaches *signal isolation* and a four-wire connection: “Thus, the podule 300 supplies *signal isolation*, provides power, and completes a two to four wire connection.” Erikson at col. 10:29-31.

Cisco's Resp. Br. 12 (emphasis added).

As we note above, the Examiner adopted Cisco's proposed rejection of claim 7 in Cisco's Request and therefore relied upon the discussion in Erekson regarding signal isolation that Cisco quoted in its Respondent Brief. Riparius's Rebuttal Brief therefore did not respond with particularity to the Examiner's rejection (via Cisco's Request) of claim 7.

Because we have not found where Riparius's briefs argued the patentability of claim 7 with particularity, and Riparius's Rehearing Request has not informed us where it did so, we conclude that we did not misapprehend or overlook arguments in support of the patentability of claim 7.

Accordingly, we deny rehearing regarding claim 7.

Claim 21

Riparius states that "[t]he [Board's] Decision, says, however, Riparius did not argue claim 21 with particularity. (Decision 29)." Req. Reh'g 6. Our full statement was: "As indicated above, the Examiner rejected this claim as obvious over Erekson, Prentice, and Rose. We sustain *this* rejection because Riparius has not argued it separately with particularity." Dec. 29 (emphasis added).

Riparius next states

On the contrary, Riparius did argue claim 21. Its brief identified two rejections of claim 21, and said that claim 21 should be considered in the group of claims 7, 8, and 21. (Riparius Appeal Brief, at 10, twice at 11, at 24, twice at 40).

We now address these assertions.

We agree that Riparius did identify two prior art rejections of claim 21. *See* App. Br. 10, rejection 21, Peterson in view of Foo and Danne; and App. Br. 11,

rejection 24, Erikson in view of Prentice and Rose. Riparius also identified a Section 112 rejection of claim 21. *See* App. Br. 11, rejection 27. Neither identification of the prior art rejections, without further discussion, is an argument for patentability with particularity.

We have not found where Riparius's Appeal Brief "said that claim 21 should be considered in the group of claims 7, 8 and 21". Page 10 of Riparius's Appeal Brief does not refer to claims 7 or 8. Although page 10 of Riparius's Appeal Brief does refer to claim 21 once, it states the following: "Whether claim 21 should have been rejected as obvious based on Peterson in view of Foo and Danne." This statement does not refer to the Examiner's rejection of claim 21 as obvious over Erikson, Prentice, and Rose.

Page 11 of Riparius's Appeal Brief does refer once (not twice) to the rejection of claim 21 as obvious over Erikson in view of Prentice and Rose. The other references to claim 21 on page 11 twice refer to a rejection under 35 U.S.C. § 112, second paragraph; and a general statement that one of the issues on appeal was whether claim 21 (grouped with other claims including claims 7 and 8 which were in turn included in a general grouping of claims 1-12) were "obvious in light of the references identified by the Examiner.").

Page 24 of Riparius's Appeal Brief refers indirectly to claim 21 by stating that the Foo reference "is a reference in rejection[] . . . 21." Rejection 21, in turn, states: "Whether claim 21 should have been rejected as obvious based on Peterson in view of Foo and Danne." This statement does not refer to the Examiner's rejection of claim 21 as obvious over Erikson, Prentice, and Rose.

Although page 40 of Riparius's Appeal Brief does refer twice to claim 21, the references are both in the context of § 112 rejections, not in the context of the *Erekson*, *Prentice*, *Rose* prior art rejection.

Riparius finally contends that

Riparius argued claims 7 and 21 as well:

And, even if claim 1 did not require the use of a non-standard phone, claim 7 certainly does because it explicitly requires that a standard, unisolated two-wire configuration cannot be used. See claim 21, too.

(Riparius Appeal Brief, at 36).

Req. Reh'g 6.

Claim 21 recites: "A device as in claim 1 wherein said audio information transmitted from said handset to the computer is isolated from audio information received by said handset from the computer." The Examiner adopted Cisco's proposed rejection of claim 21 as obvious over *Erekson* in view of *Prentice* and *Rose* as set forth in Cisco's Response "to Patent Owner's amendment following the First Action." RAN 15-16, referring to pages 43-45 of Cisco's Comments filed on October 13, 2010 ("Cisco's 10/13/2010 Comments"). Riparius's statement "See claim 21 too" is not an argument for patentability of claim 21 with particularity.

Because we have not found where Riparius's briefs argued the patentability of claim 21 over *Erekson*, *Prentice*, and *Rose* with particularity, and Riparius has not informed us where it did so, we conclude that we did not misapprehend or overlook arguments in support of the patentability of claim 21. Accordingly, we deny rehearing regarding claim 21.

CLAIM 1

Whether Riparius identified limitations in claim 1 that show the use of a specialized device and excluded a standard phone

Riparius contends that our Decision incorrectly concluded that “Riparius did not identify ‘a specific claim term for construction’ that would cause claim 1 to exclude a standard telephone.” Req. Reh’g 7, citing Decision 25. Riparius also contends that we reached that conclusion based only upon arguments of counsel for Cisco and Skype, without considering arguments by Riparius’s counsel at the hearing. Req. Reh’g 7-8. We disagree. We expressly considered, and disagreed with, the argument of Riparius’s counsel. *See* Dec. 25, citing the argument of Riparius’s counsel at Tr. 14:1-3.

Riparius also contends we did not consider its counsel’s argument reproduced at pages 48-49 of the transcript, referring to two kinds of circuitry in the base recited in claim 1: circuitry for translating communications and circuitry for receiving digital data and translating the digital data. *See* Req. Reh’g 8-9. According to Riparius, these limitations “show the use of a specialized device with two circuits, one for transmission and one for reception.” Req. Reh’g 9.

37 C.F.R. § 41.73(e)(1) states: “At the oral hearing, each appellant . . . may only . . . present argument that has been relied upon in the briefs” with an exception that does not apply here.

Neither Riparius’s oral argument nor its Request for Rehearing informs us where its briefs contended that the two base circuitry limitations showed the use of a specialized device *and* excluded a standard phone. We have not found any such arguments in Riparius’s briefs. Instead, Riparius contended that “Peterson’s phone is not specialized . . . because it has no isolated circuitry” (App. Br. 26); “Claim 1

requires that the base contain ‘circuitry for translating communications from said handset rf transceiver into digital form for transmission to a computer.’” (App.Br. 37); and “Neither Papadopoulos or McKinnon discloses the base circuitry required by claim 1” (App. Br. 37). Moreover, as noted in the transcript reproduced on page 8 of the Request for Rehearing, Riparius’s counsel effectively acknowledged that Riparius had not presented an argument with particularity in its briefs: “The third reason I think it’s in the claim and this is something we should have flagged for you better than we did . . . I don’t even think this was gone into any real detail on the reexaminations.”

Even if we were to consider this argument now, we conclude that Riparius’s briefs did not contest the Examiner’s finding, adopted from Cisco’s proposed rejection over Erikson and Prentice, that Erikson teaches both “circuitry” limitations. *See* Cisco Request 123-126 and Cisco’s Exhibit U 7-9. Riparius has not pointed us to anything in their briefs suggesting that it did contest these Examiner findings.

Accordingly, we conclude that we did not misapprehend or overlook arguments regarding the base “circuitry” limitations and we deny rehearing on that basis.

Finally, Riparius asks us to return this case to the Examiner “so that Riparius can amend claim 1.” Because Riparius does not explain why it did not avail itself of the opportunity to amend claim 1 during reexamination, we decline to order a remand.

DYNAMIC ADDRESSING

The Examiner rejected claim 1 based only on prior art (Dec. 7) and rejected claim 22 based on prior art, § 112, first paragraph, and § 112, second paragraph.

Dec. 7-8. The Examiner did not reject claim 1 based on § 112. Nevertheless, the Request for Rehearing seems to suggest that claim 1 was rejected based on § 112: “the limitation of claim 1 (“telephony software utilized by Internet telephony providers”) includes such [IP and dynamic] addressing. There is no violation of the written description requirement. Riparius respectfully requests that the rejection of claims 1 and 22 be reversed.” Req. Reh’g. 10. We do not consider further whether the Request for Rehearing seeks to contest an *unstated* § 112 rejection of claim 1.

In addition, citing only page 23 of the Decision, the Request for Rehearing disagrees with the Decision’s application of *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc) and the Decision’s conclusion that “the specification does not disclose dynamic Internet protocol addressing.” Req. Reh’g 9. Page 23 of the Decision discusses only the § 112, first paragraph rejection of claim 22.

The Decision stated that “[t]he Examiner finds that the Specification does not support or make any mention of dynamic IP addressing. RAN 8, 17. Riparius does not disagree.” Dec. 23. The Request for Rehearing still does not identify anything in the Specification that mentions dynamic IP addressing.

Instead, referring to paragraphs 3-9 of Mr. McElhaney’s Second Declaration pursuant to Rule 132, the Request for Rehearing contends that “Mr. McElvaney’s declarations, as a person of skill in the art” (Req. Reh’g 10) support the following assertions.

First Riparius asserts, “[d]ynamic addresses are the norm.” Req. Reh’g 10, citing Second Declaration ¶ 3. Instead, paragraph 3 states that “[d]ynamic addresses are the general rule, not the exception.” Even if the two phrases are

equivalent, paragraph 3 impliedly leaves open the availability and use of non-dynamic addresses.

Second, Riparius asserts, “[u]sers communicate with a server on the Internet that contains dynamic addresses of the users.” *Id.*, ¶¶ 4, 5. Riparius apparently infers that this statement is supported by the following statement in paragraph 4: “the major function of ITSP’s is to provide a mechanism for the vast majority of users with private and/or dynamic addresses to each other via the ITSP server.” Paragraph 4 also states: “The IP addresses described in Erikson have to be known beforehand; they are static.” Paragraph 4, accordingly, shows directly and impliedly that not all addresses are dynamic addresses. Reference to the “vast majority” of users is not all encompassing.

Third, Riparius asserts, “[t]elephony service providers do not use permanent addresses. *Id.* ¶ 6.” Instead, paragraph 6 states that “[a]n Internet service provider does not *assign* a permanent address.” (emphasis added). Again, even if the two statements are equivalent, paragraph 6 does not exclude the use of a non-dynamic address.

Fourth, Riparius asserts, “[t]he provider’s server keeps track of addresses and user on-line status. *Id.* ¶¶ 7-9.”

Relying upon the above-cited parts of the Second Declaration, Riparius contends

The knowledge of those skilled in the art is that the Internet telephony providers and programs described in the specification *necessarily* employ IP addressing and dynamic addressing. The specification therefore does disclose such a capability, and the limitation of claim 1 (“telephony software utilized by Internet telephony providers”) includes such addressing.

Req.Reh’g 10 (emphasis added). As we have shown above, however, the Second Declaration does not support Riparius’s assertion that its Specification necessarily employs dynamic addressing or its implied assertion that its Specification excludes non-dynamic addressing.

We agree with Riparius that *Ariad* identifies factors to consider when determining whether the Specification satisfies the written description requirement. Req. Reh. 9. Riparius does not, however, address our reference to *Ariad*’s holding that “a description that merely renders the invention obvious does not satisfy the [written description] requirement.” 598 F.3d at 1352. Dec. 23. Therefore, even if it would have been obvious to use a dynamic address in Riparius’s system, the Specification would not satisfy the written description requirement at least because the Specification does not expressly refer to a dynamic address and the Second Declaration does not establish the Specification necessarily employs dynamic addressing and/or excludes non-dynamic addressing.

For all of the above reasons, we conclude that we did not misapprehend or overlook any of Riparius’s arguments regarding the § 112, first paragraph rejection of claim 22 and we deny rehearing regarding the rejection of claim 22.

Riparius again asks us to return the case to the Examiner “so that amendments to the claims may be proposed.” Req. Reh’g 11. Again, we decline to do so.

We have granted Riparius’s request for rehearing to the extent that we have reconsidered our Decision affirming the Examiner’s decision unfavorable to patentability; but we decline to modify our decision in any way.

Pursuant to 37 C.F.R. § 41.79(d), this decision is final for the purpose of judicial review. A party seeking judicial review must timely serve notice on the

Appeal 2013-006854
Reexamination Control 95/000,502 and 95/001,164 (merged)
Patent 7,139,371 B2

Director of the United States Patent and Trademark Office. *See* 37 C.F.R. §§ 90.1
and 1.983.

REHEARING DENIED

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